



27 MAY 2008

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In re Application of :
ADLHOCH et al. :
U.S. Application No. 10/582,352 :
PCT No.: PCT/EP05/08516 :
Int. Filing Date: 05 August 2005 :
Priority Date: 09 August 2004 :
Attorney Docket No.: (06:73) :
For: METHOD FOR DETERMINATION OF :
THE PRESTRESSING FORCE OF :
CONNECTING COMPONENTS BY :
ULTRASOUND EXCITATION :

DECISION ON PETITION

This decision is issued in response to applicants' Renewed Petition under 37 CFR 1.47(a) filed 25 April 2008 to accept the application without the signature of joint-inventor, Wolfgang Grill.

BACKGROUND

On 05 August 2005, applicants filed international application PCT/EP05/08516 which claimed a priority date of 09 August 2004. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 09 June 2006.

On 09 June 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and an application data sheet.

On 16 October 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 09 January 2008, applicants filed a petition under 37 CFR 1.47(a). In a decision dated 25 January 2008, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 25 April 2008, applicants filed the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Applicants have satisfied Item (1), (3) and (4).

Regarding item (2), MPEP section 409.03(d) states that "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, the evidence regarding the refusal of the inventor to sign the application is contained in the "Statement of Facts Regarding Refusal to Sign of Wolfgang Grill" executed by Wolfram J. Horschler. Mr. Horschler is the proper person to be making this declaration, since he is the person who attempted to obtain the nonsigning inventor's signature and he therefore has the "firsthand" knowledge required by the M.P.E.P. However, Mr. Horschler's declaration does not contain evidence that a copy of the complete application papers (specification, including claims, drawings, and oath or declaration) was mailed to the nonsigning inventor, as required before a refusal to sign can be alleged. Because the petition does not include evidence that the nonsigning inventor has been sent a copy of the complete application papers, item (2) above is not satisfied.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Wolfgang Grill under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration

request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."
No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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